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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,515	02/23/2001	Tetsuro Wada	1900/00021	8620

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EXAMINER
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GRAY, JILL M

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



# Office Action Summary

Application No.

09/763,515

Applicant(s)

WADA ET AL.

Examiner

Jill M. Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.



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## **DETAILED ACTION**

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

Prior art reference EP 0 822,527 A1 has not been considered due to the absence of a PTO 1449 and English language translation.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a metallic core member, does not reasonably provide enablement for nonmetallic core members. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. In particular, the language of "soft magnetic fiber" is broad and encompasses metallic and nonmetallic magnetic fibers. Applicants' specification only provides support for metallic magnetic fibers. Accordingly, the specification is not commensurate in scope with the claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.



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Claims 2-3 and 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More specifically, claims 2-3 and 6-7 are indefinite because the language of "in the vicinity of" is vague and does not clearly identify the structural relationship of the semi-hard magnetic material or thermal welding thread to the core member and cover member. Accordingly, the metes and bounds for which patent protection is being sought are not clear.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer 4,301,428.

Mayer teaches a cable and method of making, comprising at least one conductor which has at least one element having a composite structure comprising a filament core coated with a metal or metal-like layer, wherein said conductor has a covering member comprising a nonmetal coated thereon, as required by claims 1 and 5. See column 1, line 67 through column 2, and line 3, and Figure 1a. The metal can be magnetic, such as iron or nickel or alloys and the metal-coated fibers can be assembled to form a "conductive thread". See column 4, lines 40-45 and 6, lines 24-32. As to claims 2 and



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6, Mayer teaches in Figure 1a (column 3, lines 18-23) a magnetic material disposed between the core conductor and insulating cover. As to claims 3 and 7, Mayer teaches in Figure 1b, (column 3, lines 24-27), threads disposed "in the vicinity" of the core. The threads can be synthetic fibers, which inherently are "thermal welding." As to claims 4 and 8-9, Mayer teaches a metal-coated tape, which is substantially the same as a ribbon. The skilled artisan would immediately envisage a metal ribbon from this teaching. As to the method steps of "covering a periphery of a core member" or "covering peripheries of a core member", per claims 5-7, these method steps are implied in Figures 1a and 1b, and would have provided direction to the skilled artisan at the time the invention was made to perform said steps in order to produce the cables of Mayer.

It is noted that Mayer does not teach "a security thread"; however, it is the examiner's position that in this case, the claim preamble is not necessary to give life, meaning, and vitality to the claims and does not limit the structure of the claimed invention.

Therefore, the teachings of Mayer would have rendered obvious the invention as claimed in the present claims.

Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandor et al, 6,127,028 (Sandor).

Sandor teaches a composite yarn comprising filled cut resistant fibers as a core, and having a reinforcing fiber wrapped thereon, as required by claims 1 and 5. See column 7, lines 55-60. The filled cut resistant fibers comprise fiber forming polymer and



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a hard filler (see abstract), wherein the hard filler can be a metal such as iron or nickel, which are known magnetic materials. See column 5, lines 13-14. Sandor does not specifically teach "a security thread"; however, it is the examiner's position that in this case, the claim preamble is not necessary to give life, meaning, and vitality to the claims and does not limit the structure of the claimed invention. Moreover, Sandors' teachings of the formation of fibers and yarns that are used to make fabrics would have provided motivation to the skilled artisan at the time the invention was made to form threads from his cut resistant fibers, with the reasonable expectation of producing fabrics having improved cut protection.

Therefore, the teachings of Sandor would have rendered obvious the invention as claimed in the present claims.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 13 of



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copending Application No. 10/089,849. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to incorporate the security thread of the present invention into a fixture or device.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

No claims are allowed.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

In particular, Rodgers, US2003/0059609 A1 teaches a sheath-core fiber for magnetic fabrics comprising a magnetic core fiber and a textile sheath surrounding the magnetic core fiber. See claims 11-15.

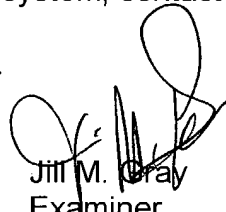
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-F 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jill M. Gray  
Examiner  
Art Unit 1774

jmg